

**REMARKS**

**I. STATUS OF THE APPLICATION**

Claims 1-33 were originally filed in the present case. Claims 34-44 were added in a Preliminary Amendment mailed May 14, 2004. In an Amendment accompanying the Response to Office Action mailed May 17, 2005, the Applicants have cancelled claims 1-44, and added claims 45-83. In the present Amendment and Response to the Final Office Action of October 13, 2006 the Applicants have amended claims 45 – 49, 74 and 75. Therefore, claims 45 - 83 are currently pending.

In a section entitled “DETAILED ACTION” of the Final Office Action of October 13, 2006 the Examiner states:

“In response to the applicant’s contention that the examiner has impermissibly withdrawn claims to non-elected species, it is noted that the claims are properly currently withdrawn pursuant to 37 CFR 1.142(b) since there is **currently** no allowable generic or linking claim. *Upon allowance of a generic claim*, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all of the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). Claims 48, 49, 55-72 and 81-83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable or generic linking claim. Election was made without traverse in the reply filed on 6/21/05 and 2/17/06.” (Final Office Action of October 13, 2006, page 2. Emphasis and bold and italics in the original.)

The Applicants believe that claim 45 is allowable and presents a proper linking claim. If linking claim 45 is allowed, then claims 48, 49, 55-72 and 81-83 are examinable and allowable.

## **II. REJECTIONS**

For clarity, the rejections are set forth in the order that they are herein addressed.

### **A. Response to Arguments**

In a section labeled “Response to Arguments” of the Final Office Action of October 13, 2006 the Examiner states:

“In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., a plurality of simultaneously visible secondary horizontal cross-hairs and a plurality of simultaneously visible secondary vertical cross-hairs) are not recited in the rejected claim(s).” (Final Office Action of October 13, 2006, page 3. *Italics in the original.*)

The Applicant’s respectfully disagree. However, in order to expedite the patent application process in a manner consistent with the U.S. Patent and Trademark Office’s Patent Business Goals (PBG)<sup>1</sup>, and without waiving the right to prosecute the amended or cancelled claims (or similar claims) in the future, in the present Amendment and Response to Final Office Action of October 13, 2006, claim 45 is amended herein to read: “a plurality of simultaneously visible secondary horizontal cross-hairs at predetermined distances along a simultaneously visible primary vertical cross-hair; and a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at least some of said secondary horizontal cross-hairs;”. Claim 46 is amended to read: “a simultaneously visible primary horizontal cross-hair.” Claim 74 is amended to read: “a simultaneously visible primary vertical cross-hair and a simultaneously visible primary horizontal cross-hair”. And claim 75 is amended to read: “1) a plurality of simultaneously visible secondary horizontal cross-hairs at a predetermined distance along a simultaneously visible primary vertical cross-hair; and 2)

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<sup>1</sup> 65 Fed. Reb. 54603 (Sept. 8, 2000).

a plurality of simultaneously visible secondary vertical cross-hairs”.

In view of the above, the Applicants request that this rejection be withdrawn.

As well, claims 45 – 49 have been amended to delete “the” in “~~the~~ said primary vertical and horizontal cross-hairs” of claims 45 – 49.

**B. 35 U.S.C. §102**

In the Final Office Action of October 13, 2006, claims 45, 46, 50, 51, 53, 73, and 75-80 are rejected as being anticipated by Reed (US Patent #4,695,161), hereinafter “Reed”. (Office Action of May 4, 2006, page 3.)

The Federal Circuit has stated the relevant analysis for anticipation as follows:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference."<sup>2</sup>

The Applicants respectfully submit that the reference cited by the Examiner fails to teach each and every element as set forth in the claims.

In the Final Office Action of October 13, 2006 the Examiner asserts with Regard to Reed:

“Each of the plurality of secondary cross-hairs, the plurality of secondary vertical cross-hairs are visible although not necessarily simultaneously visible, however it is noted that simultaneous visible cross-hairs is not required.” (Final Office Action of October 13, 2006, page 4.)

As detailed above in Section II. A. entitled “Response to Arguments” of the present Amendment and Response to Final Office Action of October 13, 2006, the Applicants have amended claims 45, 46, 74 and 75 to recite a plurality of “simultaneously visible” secondary horizontal cross hairs, primary vertical cross-hairs and secondary vertical cross- hairs (Claims 45 and 75), a “simultaneously visible”

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<sup>2</sup> *Verdegaal Bros. V. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

primary horizontal cross-hair (Claim 46), and a “simultaneously visible” primary vertical cross-hair and primary horizontal cross-hair (Claim 74). Clearly, Reed does not teach the simultaneously visible cross-hairs of the reticle of the present invention.

In view of the above, the Applicants request that this rejection be withdrawn.

**C. 35 U.S.C. §103(a)**

In the Office Action of May 4, 2006 claims 47, 52 and 54 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reed as applied to claims 45 and 46, and further in view of Wascher *et al.* (US Patent #5,491,546), hereinafter “Wascher”. As well, claim 74 is rejected under 35 U.S.C. §103(a) as being unpatentable over Reed applied to claim 45, and further in view of Cohen (US Patent #5,375,073), hereinafter “Cohen”. (Final Office Action of October 13, 2006, page 5)

A *prima facie* case of obviousness requires the Examiner to cite to a reference which a) discloses all the elements of the claimed invention, b) suggests or motivates one of ordinary skill in the art to combine the claim elements to yield the claimed invention, and c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements negates a finding of a *prima facie* case and, without more, entitles the Applicants to allowance of the claims in issue. (MPEP)

The Applicants note that the Examiner’s combinations of references do not teach all elements of the claims. For example, none of the Examiner’s references, alone or in combination, recite a plurality of simultaneously visible secondary horizontal cross-hairs at predetermined distances along a simultaneously visible primary vertical cross-hair. As well, none of the Examiner’s references, alone or in combination, recite a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at least some of the simultaneously visible secondary horizontal cross-hairs. Moreover, none of the Examiner’s references, alone or in combination, recite the combination of a plurality of a simultaneously visible secondary horizontal cross-hair at predetermined distances along a simultaneously visible primary vertical cross-hair, with a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at

least some of the simultaneously secondary horizontal cross-hairs, and a simultaneously visible primary horizontal cross-hair

In view of the above, the Applicants request that this rejection be withdrawn.

**CONCLUSION**

All grounds of rejection of the Final Office Action of October 13, 2006 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application the Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

Dated: 1/4/07



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